

IN THE DRAWINGS

Submitted herewith are replacement sheets for Figures 1, 2, and 3. The drawings have been amended to include text and a descriptive legend as requested in the Office Action. No new matter has been added to the application.

Remarks

The Office Action mailed June 15, 2005, and made final, has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-12 are cancelled. Claims 13-48 are pending. Claims 13-48 are rejected.

Applicants note the objections to the drawings. Submitted herewith are replacement sheets for Figures 1, 2, and 3. The drawings have been amended to include text and a descriptive legend as requested in the Office Action. No new matter has been added to the application. For the reasons set forth above, Applicants request that the objections to the drawings be withdrawn.

Applicants respectfully traverse the objection to the disclosure. The specification has been amended to address the informalities noted in the Office Action. For the reasons set forth above, Applicants request that the objection to the disclosure be withdrawn.

The rejection of Claims 13 and 34 under 35 U.S.C. § 112 is respectfully traversed. Claims 13 and 34 have been amended to address the issues noted in the Office Action. For the reasons set forth above, Applicants respectfully request that the Section 112 rejections of Claims 13 and 34 be withdrawn.

The rejection of Claims 13-48 under 35 U.S.C. § 103(a) as being unpatentable over Jonstromer (6,142,369) in view of Kawan (5,796,832) is respectfully traversed.

Jonstromer describes an electronic transaction system for conducting electronic financial transactions including a smart card configured to store a plurality of payer electronic credits and a communication module configured to transmit the electronic credits from the smart card to a party selected from a plurality of addressable parties accessible through a Public Switched Telephone Network. See Abstract. Referring to Column 3, lines 50-59, Jonstromer describes that a communications module transmits a signal indicating an amount to be transferred, an address of a payee, an account number and an electronic signature of a payer to an electronic banking terminal at the bank. Further, the electronic banking terminal authenticates the

electronic signature, debits the account of the payer and credits the account of the payee, and the electronic banking terminal transmits a signal to the electronic till of the payee confirming payment.

Kawan, referencing Figure 2B, describes a wireless transmitting and receiving station 54 that is operatively linked to a financial server 56 associated with LAN or WAN of a business. Various nodes 58, 60, and 64 are provided along the network of the business. One such node 64 may comprise a personal computer which includes a smart card reader 64a. Now referencing Figure 2C, Kawan describes that a cellular telephone 75 serves as a financial information and transaction terminal. Specifically, the cellular telephone 75 includes standard features such as an alpha-numerical keypad 80, a speaker portion 76, a microphone portion 82, and a display 78 (for example, a LCD display). Additionally, a smart card reader portion 84 is provided which provides the additional capability to perform financial transactions using the keypad 80 as an interface.

Claim 13 recites a method for digital signing of a message which is transmitted via a communication network to a signing unit. The method includes transmitting from a transmitter a message to be signed to a first receiver, and transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone comprising a signing unit.

The Office Action, at page 5, asserts that the system configuration of Figure 2B is illustrative of a method that includes transmitting from a transmitter a message to be signed to a receiver. However, transmission of such a message is never described in Kawan. While Kawan does describe that when funds are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are "real", there is no description of a transmitter transmitting a message to be signed to a receiver, which then transmits the message to be signed from the receiver to a mobile radio telephone that includes a signing unit. Therefore neither of Jonstromer and Kawan describe or suggest a transmitter transmitting a message to be signed to a receiver, nor a receiver that transmits the message to be signed to a mobile radio telephone that includes a signing unit.

For the reasons set forth above, Claim 13 is submitted to be patentable over Jonstromer in view of Kawan.

Claims 14-20 depend, directly or indirectly, from independent Claim 13. When the recitations of Claims 14-20 are considered in combination with the recitations of Claim 13, Applicants submit that dependent Claims 14-20 likewise are patentable over Jonstromer in view of Kawan.

Claim 21 recites a signed message created by the process of Claim 13. As described above, Jonstromer in view of Kawan. do not describe, nor suggest, a transmitter transmitting a message to be signed to a receiver, which then transmits the message to be signed from the receiver to a mobile radio telephone that includes a signing unit. Therefore neither of Jonstromer and Kawan describe or suggest a transmitter transmitted a message to be signed to a receiver, nor a receiver that transmits the message to be signed to a mobile radio telephone that includes a signing unit.

For the reasons set forth above, Claim 21 is submitted to be patentable over Jonstromer in view of Kawan.

Claim 22 recites a method for digitally signing, by means of a signing apparatus, a message to be transmitted to a receiving device. The message to be signed is transmitted from a transmitting device to a receiving device, this message is then transmitted from the receiving device via a telephone network to a signing apparatus associated with the transmitting device. The message is then signed in the signing apparatus and transmitted back to the receiving device as a signed message.

Jonstromer in view of Kawan do not describe nor suggest a method that includes transmitting a message to be signed from a transmitting device to a receiving device, where this message is then transmitted from the receiving device via a telephone network to a signing apparatus associated with the transmitting device. Rather, Jonstromer describes a communications module that transmits a signal indicating at least an electronic signature of a payer to an electronic banking terminal at the bank. The electronic banking terminal at least

authenticates the electronic signature and transmits a signal to the electronic till of the payee confirming payment. Kawan does describe that when funds are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are "real". However, Kawan does not describe a transmitter transmitting a message to be signed to a receiver, which then transmits the message to be signed from the receiver to a mobile radio telephone that includes a signing unit.

For the reasons set forth above, Claim 22 is submitted to be patentable over Jonstromer in view of Kawan.

Claims 23-32 depend, directly or indirectly, from independent Claim 22. When the recitations of Claims 23-32 are considered in combination with the recitations of Claim 22, Applicants submit that dependent Claims 23-32 likewise are patentable over Jonstromer in view of Kawan.

Independent Claim 33 recites a chip card for a mobile telephone, wherein the chip card incorporates a signing device which has a memory unit for storing a private key necessary for producing a signed message. The signing device generates the signed message from a message to be signed which is received by the mobile telephone via a telephone network.

Jonstromer in view of Kawan do not describe nor suggest a chip card for a mobile telephone that includes a signing device that generates a signed message from a message to be signed that was received by the mobile telephone. Rather, Jonstromer describes a communications module that transmits a signal indicating at least an electronic signature of a payer to an electronic banking terminal at the bank. The electronic banking terminal at least authenticates the electronic signature and transmits a signal to the electronic till of the payee confirming payment. Generation of the electronic signature is not described in Jonstromer. Kawan does describe that when funds are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are "real". Kawan does not describe generation of the encrypted bank signature.

For the reasons set forth above, Claim 33 is submitted to be patentable over Jonstromer in view of Kawan.

Independent Claim 34 recites a method for transport via a communication network of a message to a mobile phone and transport of a corresponding signed message. The method comprises “transmitting from a transmitter a message to be signed to a first receiver” and “transmitting the message to be signed from the receiver via a telephone network to a mobile radio telephone whereat the message to be signed may be signed, and when signed, generates a corresponding signed message.” For the reasons set forth above, Claim 34 is submitted to be patentable over Jonstromer in view of Kawan.

Claims 35-38 depend, directly or indirectly, from independent Claim 34. When the recitations of Claims 35-38 are considered in combination with the recitations of Claim 34, Applicants submit that dependent Claims 35-38 likewise are patentable over Jonstromer in view of Kawan.

Claim 39 recites a method, comprising “a mobile radio telephone user receiving a message from a telephone network” and “the user using the mobile radio telephone to generate a signed message corresponding to the received message...”.

Jonstromer in view of Kawan do not describe nor suggest a method that includes receiving a message from a telephone network and the user using the mobile radio telephone to generate a signed message corresponding to the received message. Rather, Jonstromer describes a communications module that transmits a signal indicating at least an electronic signature of a payer to an electronic banking terminal at the bank. The electronic banking terminal at least authenticates the electronic signature and transmits a signal to the electronic till of the payee confirming payment. Generation of a signed message corresponding to a received message is not described in Jonstromer. Kawan describes that when funds are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are "real". Kawan does not describe generation of the encrypted bank signature. As such, generation of a signed message corresponding to a received message is not described in Kawan.

For the reasons set forth above, Claim 39 is submitted to be patentable over Jonstromer in view of Kawan.

Claim 40 depends from independent Claim 39. When the recitations of Claim 40 are considered in combination with the recitations of Claim 39, Applicants submit that dependent Claim 40 likewise is patentable over Jonstromer in view of Kawan.

Claim 41 recites a method for operating a wireless device. The method includes receiving a message, accepting input from the user indicating the received message is to be signed, and generating a corresponding signed message.

Jonstromer in view of Kawan do not describe nor suggest a method that includes receiving a message, accepting input from the user indicating the received message is to be signed, and generating a corresponding signed message. Rather, Jonstromer describes a communications module that transmits a signal indicating at least an electronic signature of a payer to an electronic banking terminal at the bank. The electronic banking terminal at least authenticates the electronic signature and transmits a signal to the electronic till of the payee confirming payment. Generation of a signed message corresponding to a received message is not described in Jonstromer. Kawan describes that when funds are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are "real". Kawan does not describe generation of the encrypted bank signature. As such, generation of a signed message corresponding to a received message is not described in Kawan.

For the reasons set forth above, Claim 41 is submitted to be patentable over Jonstromer in view of Kawan.

Claims 42-45 depend, directly or indirectly, from independent Claim 41. When the recitations of Claims 42-45 are considered in combination with the recitations of Claim 41, Applicants submit that dependent Claims 42-45 likewise are patentable over Jonstromer in view of Kawan.

Claim 46 recites a wireless device for receiving a message to be signed and transmitting a corresponding signed message. The device includes input apparatus for accepting input from a

user indicating the received message is to be signed and memory for storing an algorithm for generating a corresponding signed message.

Jonstromer in view of Kawan do not describe nor suggest a wireless device for receiving a message to be signed and transmitting a corresponding signed message that includes input apparatus for accepting input from a user indicating the received message is to be signed and memory for storing an algorithm for generating a corresponding signed message. Rather, Jonstromer describes a communications module that transmits a signal indicating at least an electronic signature of a payer to an electronic banking terminal at the bank. The electronic banking terminal at least authenticates the electronic signature and transmits a signal to the electronic till of the payee confirming payment. Accepting input from a user indicating the received message is to be signed is not described in Jonstromer. Kawan describes that when funds are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are "real". Kawan does not describe generation of the encrypted bank signature. As such, accepting input from a user indicating the received message is to be signed is not described in Kawan.

For the reasons set forth above, Claim 46 is submitted to be patentable over Jonstromer in view of Kawan.

Claims 47-48 depend, directly or indirectly, from independent Claim 46. When the recitations of Claims 47-48 are considered in combination with the recitations of Claim 46, Applicants submit that dependent Claims 47-48 likewise are patentable over Jonstromer in view of Kawan.

For the reasons set forth above, Applicants respectfully request that the Section 103 rejection of Claims 13-48 be withdrawn.

In addition to the reasons given above, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination.

No combination of Jonstromer and Kawan. describes or suggests the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Jonstromer with Kawan because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time of the invention to employ the use of transmitting a message to be signed to a receiver and the receiver transmits the message to be signed to a mobile radio telephone in the system of Jonstromer as Kawan teaches so as to provide a flexible way of presenting messages to be signed rather than as a precise data entering in the phone system to be signed." suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Moreover, as is well established, the mere fact that the prior art structure could be modified does not make such a modification obvious unless the prior art suggests the desirability of doing so. See In re Gordon, 221 U.S.P.Q.2d 1125 (Fed. Cir. 1984). Furthermore, the Federal Circuit has determined that:

[i]t is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention."

In re Fitch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992).

Further, under Section 103, “it is impermissible...to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.” In re Wesslau, 147 USPQ 391, 393 (CCPA 1965). Rather, there must be some suggestion, outside of Applicants’ disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants’ disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the cited art, nor any reasonable expectation of success has been shown. Accordingly, since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason, along with the reason provided previously, Applicants request that the Section 103 rejection of Claims 13-48 be withdrawn.

Moreover, if art “teaches away” from a claimed invention, such a teaching supports the nonobviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Specifically, Applicants respectfully submit that Kawan and Jonstromer teach away from the present invention, and as such, there is no suggestion or motivation to combine Jonstromer with Kawan. Specifically, in contrast to the present invention, Jonstromer describes a communications module that transmits a signal indicating the amount to be transferred, the address of the payee, the account number, and an electronic signature of the payor to an electronic banking terminal at the bank, and in contrast to Jonstromer and the present invention, Kawan describe that when fund are transferred to and from a smart card, an encrypted bank signature appended to the funds certifies that the funds are real. More specifically, no combination of Jonstromer and Kawan describes or suggests an apparatus or method that includes transmitting a message to be signed to a receiver, signing the message to generate a corresponding signed message, and transmitting the corresponding signed message to one or more receivers. Accordingly, Jonstromer and Kawan teach away from the present invention, and

from each other, and as such, any combination of the cited art appears to support the nonobviousness of the present invention. Accordingly, Claims 13-48 are submitted to be patentable over Jonstromer in view of Kawan.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "Robert E. Slenker", is written over a horizontal line.

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ANNOTATED MARK-UP
DRAWING

1 / 3

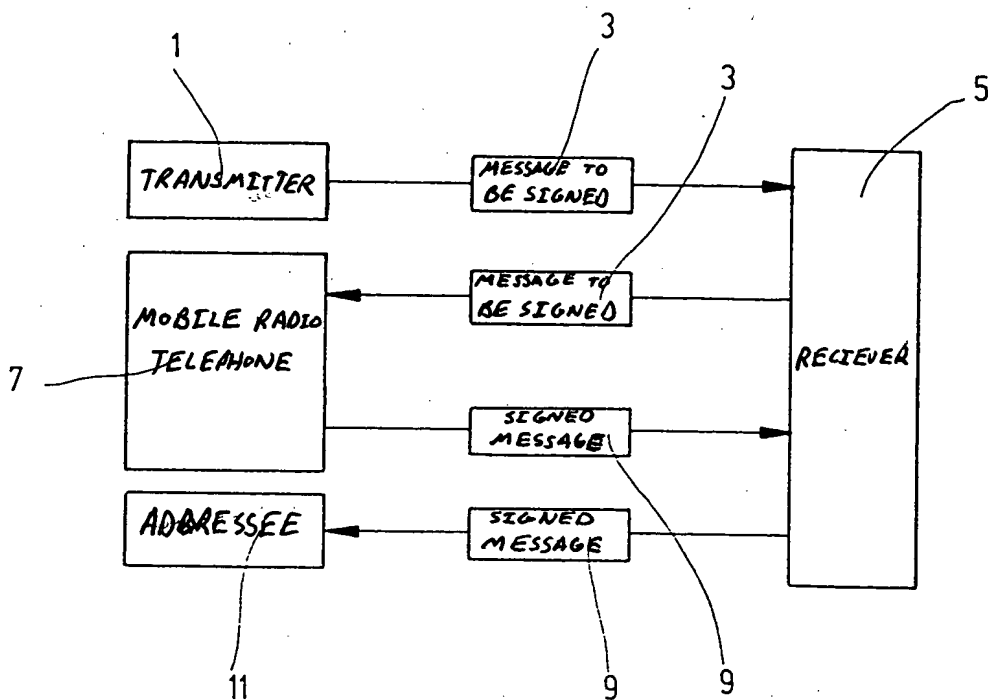


Fig.1



ANNOTATED MARK-UP DRAWING

2 / 3

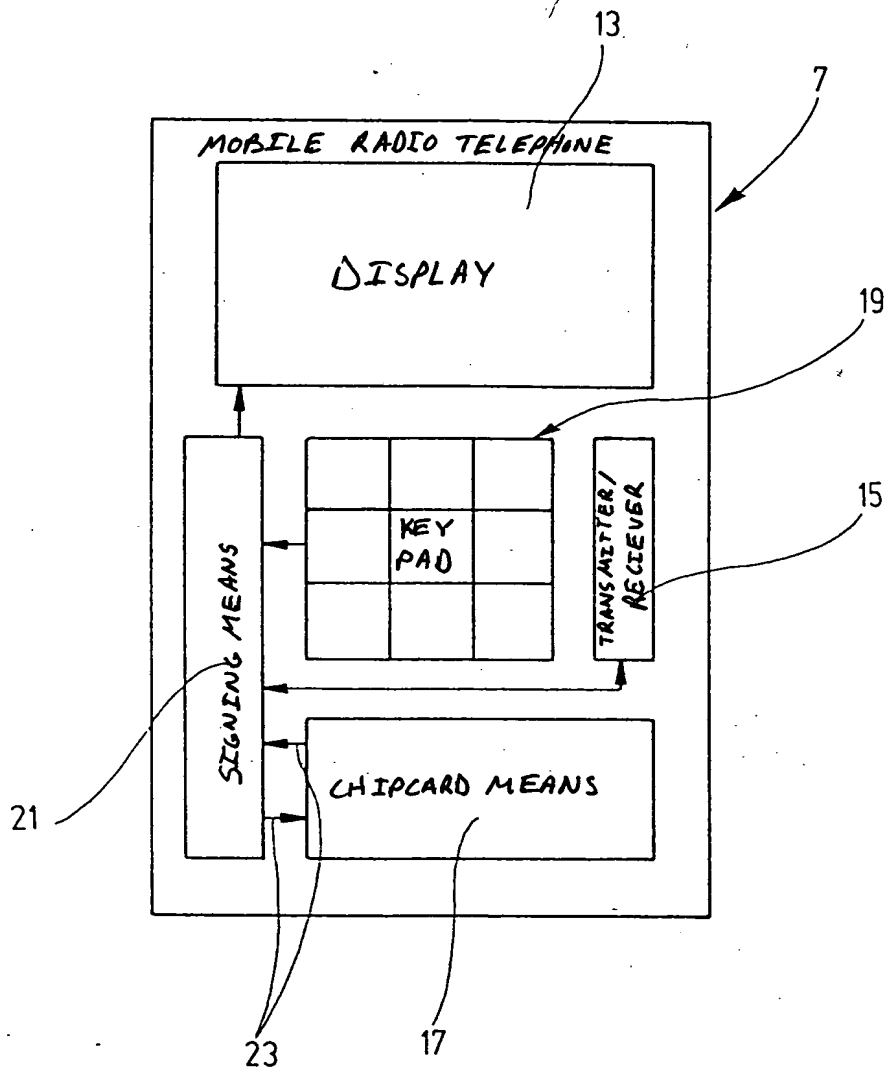


Fig. 2



ANNOTATED MARK-UP DRAWING

3 / 3

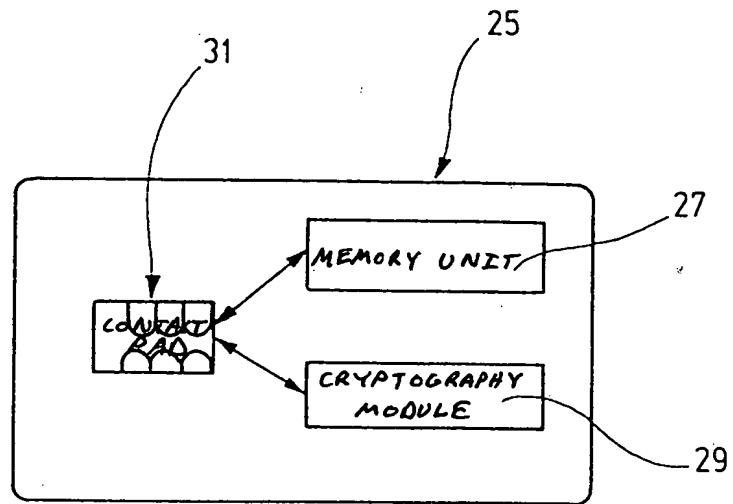


Fig. 3